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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,559	01/19/2007	Juan Carlos Lopez Calvet	1380-0231PUS1	3554
2292 7590 03/05/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
GAO, JING				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
03/05/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/594,559

Applicant(s)

CALVET ET AL.

Examiner

Jing (Kristen) GAO

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 11/25/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment, filed December 09, 2009 has been entered and carefully considered. Claims 1 and 11-17 are amended, and Claims 1-19 are currently pending.
2. Applicant's amendment to Claims 11-17 are fully considered, and objection to the claims are withdrawn.

Response to Argument

3. Applicant's arguments with respect to Claims 1-10, 18 and 19 have been fully considered but are not persuasive. Applicant argues that the combination of Hussmann and Ritter does not disclose an antenna is included in said subscriber identity module. The examiner respectfully disagrees. Hussmann teaches the RFID transponder is attached to an object and comprises an antenna (Paragraphs 0028 and 0029). Hussmann does not exclude the teaching that the RFID transponder cannot be attached to a SIM card in a mobile device. In fact, Ritter teaches a SIM card has the functionality of a RF transponder (Abstract). In addition, as a teaching reference, Duhs (WO 00/74406 A1) teaches that the RFID transponder can be integrated with battery pack, master board, SIM card, or microchip (Figures 3a-3c and Page 10). In addition, as a teaching reference, Haugli et al. (US Pub. No. 2008/0039115 A1, claims priority to NO 20043677) teaches RFID tags have become popular and may be put on a SIM card; such a solution is good when very short range is needed (Paragraph 0014). Therefore, Hussmann teaches antenna is included in said subscriber identity module.
4. Applicant's arguments with respect to Claims 11-17 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

5. The information disclosure statements (IDS) submitted on November 25, 2009 was filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 2617

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as been unpatentable over Hussmann (US Pub. No. 2003/0218532 A1), in view of Ritter (CA Pub. No. 2,293,393 A1).

Regarding to Claim 1, Hussmann teaches subscriber identity module for a mobile communication terminal (Paragraph 0011), comprising a processing device (Paragraph 0012; calculating means for calculating authentication code), a memory device (Paragraph 0011; memory for storing user-specific information), an I/O device (Paragraphs 0034 and 0035; interface in SIM) and a wireless communication device which is connected to an antenna included in said subscriber identity module (Paragraphs 0004 and 0029; RFID transponder is coupled to an antenna), characterized in that said wireless communication device is an interrogatable transponder (Paragraphs 0004 and 0016; RFID transponder). Hussmann may not specifically teach operatively controllable by said processing device and arranged to be operatively enabled or disabled, and controlled by a signal provided by the mobile communication terminal via said I/O device. In the same field of endeavor, Ritter teaches the SIM card controls the activation of the wireless transponder via a signal through contact region (Page 8 Lines 8-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have operatively controllable by said processing device and arranged to be operatively enabled or disabled, and controlled by a signal provided by the mobile communication terminal via said I/O device because it provides more flexibility in operating the system.

Regarding to Claim 2, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Ritter teaches said signal is provided by a user interface in the mobile terminal (Page 13 Lines 27 to Page 14 Lines 19; user actuates a key on keypad to make a decision).

Regarding to Claim 3, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Ritter teaches said signal is provided by a mobile communication operator (Page 13 Lines 27 to Page 14 Lines 19; user actuates a key on keypad to make a decision).

Regarding to Claim 4, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches said interrogatable transponder comprises

Art Unit: 2617

identification data contained in a memory, said identification data being configurable by said processing device (Paragraphs 0009 and 0011; the SIM is characterized by means for writing user-specific information into the transponder memory unit).

Regarding to Claim 5, the combination of Hussmann and Ritter teaches all of the limitations of Claim 4, as described above. Further, Hussmann teaches said identification data is provided by the mobile communication terminal via said I/O device (Paragraphs 0011 and 0035; the interface allows processor to write user-specific information into the transponder memory and to read information from memory).

Regarding to Claim 6, the combination of Hussmann and Ritter teaches all of the limitations of Claim 5, as described above. Further, Hussmann teaches said identification data is provided by a mobile communication operator (Paragraph 0050; user-specific information may be manually entered into a portable electronic device by using various user interfaces).

Regarding to Claim 7, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches said interrogatable transponder is arranged to transmit a RF signal coded with said identification data when interrogated by an external interrogating RF device (Paragraph 0029; the interrogating apparatus transmits a request radio signal, emitted as an electromagnetic field, picked up by transponder that causes the transponder to transmit a reply signal comprising identification data through antenna).

Regarding to Claim 8, the combination of Hussmann and Ritter teaches all of the limitations of one of the Claims 1-7, as described above. Further, Hussmann teaches said transponder is an active RFID transponder (Paragraphs 0016 and 0030; active RFID transponder).

Regarding to Claim 9, the combination of Hussmann and Ritter teaches all of the limitations of Claim 8, as described above. Further, Hussmann teaches said transponder is a separate device (Figure 2), comprising a processing device, a memory device and an I/O device connected to an antenna (Paragraph 0029; the active RFID transponder comprises an antenna, an integrated circuit and memory).

Regarding to Claim 10, the combination of Hussmann and Ritter teaches all of the limitations of Claim 9, as described above. Further, Hussmann teaches said transponder comprises an antenna (Paragraph 0029; the active RFID transponder comprises an antenna), and wherein further RFID transponder functionality is implemented by means of the processing device and the memory device included in said subscriber identity module (Paragraphs 0009 and 0011; the SIM is characterized by means of processing device and memory device for writing user-specific information into the transponder memory unit).

Regarding to Claim 18, Hussmann teaches a method for execution by a subscriber identity module, for the purpose of providing secure data communication between the subscriber identity module and an external interrogating device (Abstract), said subscriber identity module comprising a processing device (Paragraph 0012; calculating means for calculating authentication code), a memory device containing a private key (Paragraphs 0011 and 0041-0043; memory for storing user-specific information, which includes SRES), an I/O device (Paragraphs 0034 and 0035; interface in SIM), and a wireless communication device which is connected to an antenna included in said subscriber identity module (Paragraphs 0004 and 0029; RFID transponder is coupled to an antenna), the wireless communication device being an interrogatable transponder (Paragraphs 0004 and 0016; RFID transponder), said method comprising the steps of transmitting identification data upon an interrogation by the external interrogating device (Paragraph 0029; the interrogating apparatus transmits a request radio signal, emitted as an electromagnetic field, picked up by transponder that causes the transponder to transmit a reply signal comprising identification data through antenna), receiving an encrypted message from the external communication device, said message being encrypted with a public key associated with said identification data (Paragraph 0042; the interrogating apparatus emits a signal comprising a RAND-number), decrypting said encrypted message using said private key (Paragraph 0041; decrypt the message based on Ki and RAND using algorithm A3), and using the decrypted message as a shared key to encrypt further data communication between the subscriber identity module and the external interrogating device (Paragraph 0042; the transponder and the interrogating apparatus transmits signals containing SRES). Hussmann may not specifically teach operatively controllable by said processing device and arranged to

Art Unit: 2617

be operatively enabled or disabled, controlled by a signal provided by the mobile communication terminal via said I/O device. In the same field of endeavor, Ritter teaches the SIM card controls the activation of the wireless transponder via a signal through contact region (Page 8 Lines 8-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have operatively controllable by said processing device and arranged to be operatively enabled or disabled, and controlled by a signal provided by the mobile communication terminal via said I/O device because it provides more flexibility in operating the system.

Regarding to Claim 19, the combination of Hussmann and Ritter teaches all of the limitations of Claim 18, as described above. Further, Hussmann teaches said public key is provided by said external interrogating device by searching a database in order to match said identification with the corresponding public key (Paragraphs 0044-0046; interrogating apparatus obtains a RAND by first obtaining the user identity through database).

Regarding to Claim 11, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches wherein said subscriber identity module is used as an authentication token (Paragraphs 0002, 0005, 0006, 0009 and 0011; the RF transponder that could be embedded in the SIM card can be used to authenticate a user).

Regarding to Claim 12, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches wherein said subscriber identity module is used as an authentication token for an access control system (Paragraphs 0002, 0005, 0006, 0009 and 0011; the RF transponder that could be embedded in the SIM card can be used in connection with access control system, and the mobile device can be used as an access control card).

Regarding to Claim 13, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches wherein said subscriber identity module is used as an authentication token for a mobile commerce system (Paragraphs 0002, 0005, 0006, 0009, 0011 and 0038; if the identification procedure is associated with a payment, for instance the electronic payment of a bus ticket, this payment may preferably be effected via the users mobile telephony subscription).

Regarding to Claim 14, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches mobile communication terminal, comprising a subscriber identity module according to claim 1 (Paragraphs 0002, 0005, 0006, 0009 and 0011; a mobile device comprises an integrated RFID transponder and SIM card).

Regarding to Claim 15, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches a mobile communication terminal, comprising a subscriber identity module, wherein said mobile communication terminal is used as an authentication token (Paragraphs 0002, 0005, 0006, 0009 and 0011; the integrated RF transponder and SIM card in the mobile device can be used to authenticate a user carrying such a device).

Regarding to Claim 16, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches a mobile communication terminal, comprising a subscriber identity module, wherein said mobile communication terminal is used as an authentication token for an access control system (Paragraphs 0002, 0005, 0006, 0009 and 0011; the RF transponder that could be embedded in the SIM card can be used in connection with access control system, and the mobile device can be used as an access control card).

Regarding to Claim 17, the combination of Hussmann and Ritter teaches all of the limitations of Claim 1, as described above. Further, Hussmann teaches a mobile communication terminal, comprising a subscriber identity module, wherein said mobile communication terminal is used as an authentication token for a mobile commerce system (Paragraphs 0002, 0005, 0006, 0009, 0011 and 0038; if the identification procedure is associated with a payment, for instance the electronic payment of a bus ticket, this payment may preferably be effected via the users mobile telephony subscription).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2617

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jing (Kristen) GAO whose telephone number is (571)270-7226. The examiner can normally be reached on Monday-Friday, 09:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/ Supervisory Patent Examiner, Art Unit 2617	/Jing (Kristen) GAO/ Examiner, Art Unit 2617 02/25/2010
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